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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,430	11/25/2003	Neil Young	021755-000300US	6240
20350	7590	10/24/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834		ZIMMERMAN, BRIAN A		
		ART UNIT	PAPER NUMBER	2612

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/723,430	YOUNG ET AL.	
	<b>Examiner</b> Brian A. Zimmerman	<b>Art Unit</b> 2612	

*— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 28 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

***Status of Application***

In response to the applicant's amendment received on 7/27/06. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-18 are unpatentable for the reasons set forth in this office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-17,19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata in view of Borgstahl (5909183) and the admitted prior art.

Nagata shows a method for communicating to a model vehicle to program the model vehicle and then provide control signals to the model vehicle. The system of Nagata includes a control device 2 that communicates with a first device (train 1) when the first device is located near the control device; actually the first device is placed within the recess 21d of the control device. This narrow IR transmission (LED 23) is used to program the first device for future communication using a second communication link from LED 22 on the opposite side of the controller. There is also a barrier around the LED 23.

In an analogous art, Borgstahl also teaches a remote control system where the controller and the controlled object are programmed to be associated

with each other prior to the signaling to control the object. Borgstahl teaches though, the object being controlled sends a signal to the controller such that the controller can learn the identity and features of the controlled object, thereby allowing the controller to access the full features of the object being controlled. Using a bi-directional link would require a receiving element near or associated with the transmitting element 23.

Regarding claim 8, the examiner took official notice that the use of barcode as readable identifier of the train would be verily common since barcodes to identify items is often used in the art. The applicant did not question the taking of Official Notice therefore it is taken that this feature is admitted prior art. MPEP 2144.03 (c) which states:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Regarding claim 17, the examiner took official notice that the location of the elements is well within the skill of the ordinary artisan. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not

have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). The applicant did not question the taking of Official Notice therefore it is taken that this feature is admitted prior art. MPEP 2144.03 (c) .

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have had a bi-directional link for programming the train of Nagata since this would expand the control capabilities for complex trains while also requiring less memory and processing power in the actual train itself since more intelligence would be in the controller as suggested by Borgstahl.

2. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata and Borgstahl (5909183) as applied to the claims above, and further in view of Young (5749547).

In an analogous art, Young teaches the communication of commands to the train units being over the train tracks. This provides the ability to control the trains as long as they are connected to the track even when the train may be in a tunnel and be out of sight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the train tracks to communicate commands over the tracks as taught by Young, since this would ensure communication to trains on the track.

***Response to Arguments***

Applicant's arguments filed 8/28/06 have been fully considered but they are not persuasive.

The applicants argue that Nagata fails to show the step of transmitting between the first device and the remote, where the remote is only capable of receiving an ID for the first device when the remote is placed within a narrow field emanating from the device. The rejection of the claims that contain this newly added limitations are now rejection using an obviousness rejection citing Nagata and Borgstahl. Borgstahl teaches teaches a remote control system where the controller and the controlled object are programmed to be associated with each other prior to the signaling to control the object. Borgstahl teaches the object being controlled sends a signal to the controller such that the controller can learn the identity and features of the controlled object, thereby allowing the controller to access the full features of the object being controlled. Combining the teachings would provide a bi-directional link that would require a receiving element near or associated with the transmitting element 23 of Nagata much like the receiving element 25 and a transmitting element on the train. Using the transmitting element 23 and the receiving element 25 to communicate bidirectionally with the train would expand the control capabilities for complex trains by providing increased control possibilities. Having such an arrangement would limit the bi-

directional programming communication to the remote and only the train car loaded into the programmer 2 of Nagata.

The applicant argues that Nagata fails to show the step of periodically transmitting from a first train, an ID, in a limited field IR transmission. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, Borgstahl teaches the device transmitting a modulated signal that includes an ID to identify the train and enabling communication between the remote control and the device. Combined with Nagata then provides the approach to a train with the communication in the IR band.

The applicant argues that Nagata does not position a remote control device near a first train so that only a transmission from that train is received by an IR receiver in the remote control device. Nagata does position a remote controller near the first train so that only communication with that train is conducted, using IR. The addition of Borgstahl's bi-directional communication teaching, provides Nagata with receiving a signal from the train that identifies the train.

The applicant argues that Nagata does not provide a transmission so that only a narrow transmission from a single vehicle is received by the remote control unit. Nagata positions the remote controller in such a manner that only a single vehicle is 'communicating' with the remote control. Nagata also uses the cover shown in figure 4 to prevent other trains from communicating with the

remote controller. The addition of Borgstahl's bi-directional communication teaching, provides Nagata with receiving a signal from the train that identifies the train.

The applicant argues that the devices of Nagata are limited as passive recipients of commands and transmit nothing to the remote controller. The addition of Borgstahl's bi-directional communication teaching, provides Nagata with receiving a signal from the train that identifies the train to establish communication with the remote controller.

The applicant argues that the statement of motivation is insufficient. It is believed that the applicant is questioning the validity of the motivation statement, since a measure of sufficiency is not address by the arguments that follow as related to what is required in the motivation statement. The applicant argues that it is unclear how the addition of an ID transmitter in the train of Nagata would expand the control capabilities for complex trains. Using the bi-directional teaching Borgstahl to make transmitting element 23 and the receiving element 25 to communicate bidirectionally with the train would expand the control capabilities for complex trains by providing increased control possibilities since the user would be able to specify commands for specific trains, once the identity of the trains are known, in systems where a plurality of trains exist.

The applicant argues that the addition of an ID transmitter would increase the complexity of the train, not decrease the complexity as set forth in the motivation statement. The motivation statement is specifically addressed to

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reducing the amount of memory and processing power required in the train, thus making these elements in the train less complex.

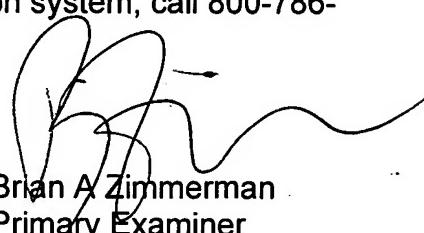
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on 7 am to 4 pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brian A Zimmerman  
Primary Examiner  
Art Unit 2612

BZ